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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,325	07/22/2003	Wealthy Desai	9400-34	7298
36072 7590 07/09/2008 MYERS BIGEL SIBLEY & SAJOVEC, P.A. P.O. BOX 37428 RALEIGH, NC 27627				
EXAMINER				
LEVINE, ADAM L				
ART UNIT		PAPER NUMBER		
3625				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/624,325

Applicant(s)

DESAI, WEALTHY

Examiner

ADAM LEVINE

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 6-16, 19-30, 32, 34-44, 47-58, 60, 62-72 and 75-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4, 6-16, 19-30, 32, 34-44, 47-58, 60, 62-72, and 75-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's amendments and remarks filed March 24, 2008, are responsive to the office action mailed December 31, 2007. In this response, applicant has amended claims 1,16,24,29, 44,52,57,72, and 80. Claims 1-2,4,6-16,19-30,32,34-44,47-58,60,62-72, and 75-85 are pending and examined in this office action.

Response to Arguments

Applicant's arguments, see remarks, filed March 24, 2008, with respect to the rejection(s) of claim(s) 1-2,4,6-16,19-30,32,34-44,47-58,60,62-72, and 75-85 under 35 USC 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Lamburt (Paper #20061105; US Patent No.6,374,241), and further in view of Superpages (a collection of prior art cited in Paper # 050715, PTO-892, Items U1-X7; See MPEP §2131.01).

Pertaining to rejection of claims under 35 USC §102(b) in the previous office action

In response to applicant's argument that "the ordinarily skilled artisan in view of Lamburt would expect that the only ordering options for listing enhancements in Lamburt would require interfacing with a sales representative." It is noted with regard to this application and this argument that if such an expectation is present within the art then it would also apply to the present application. If such an implication is automatic, as argued by the applicant, then there is nothing indicating that the present invention

does not do the same. Recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With regard to applicant's argument addressing claims 16,24,44,52,72, and 80, applicant argues that the specification provides support for the issuing of a bill by implication. If the limitation is so prevalent within the prior art as to be capable of disclosure by implication then arguing that it is novel and non-obvious is quite simply an illogical contradiction in concepts. The examiner therefore considers the argument that the feature is supported by implication to be an admission that the limitation is not novel or non-obvious. In any case, while the examiner agrees that issuing a bill to a customer using billing information is old and well known, the examiner does not agree that the mere solicitation of such information implicitly discloses issuing a bill. The solicitation of the information does not require the issuing of a bill and vice versa.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 16,24-28,44,52-56,72, and 80-84 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A description of how the billing information is used to issue a bill to the consumer, critical or essential to the

practice of the invention but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention without undue experimentation. This is because the specification did not in any way disclose issuing a bill. While a person of ordinary skill in the art would understand how to issue a bill using the information, in this case it would be impossible to determine how this was intended to be accomplished in the present invention and in fact, because the issuing of a bill is not disclosed at all, a person of ordinary skill in the art would not have any reason to expect that the issuing of a bill was an intended element of the invention. As a result, these claims also are rejected for failure to comply with the written description requirement. They contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the invention now claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-2,4,6-15,19-23,29-30,32,34-43,47-51,57-58,60,62-71, 75-79 and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamburt (Paper #20061105; US Patent No.6,374,241) in view of Superpages (a collection of prior art cited in Paper # 050715, PTO-892, Items U1-X7; See MPEP §2131.01).**

Lamburt teaches a providing a business directory, soliciting orders for listings in a business directory, providing a website accessible by customers, displaying listing options and enhancements available to customers for enhancing their business listings, and displaying price quotes for customized business listings. For example, Lamburt discloses a method for providing a Web site accessible by a customer and receiving an order request from the customer via the Web site to place an order for the particular, unique, individualized, customized business listing in a business directory including the first and second optional listing enhancements requested by the customer (see at least figs.10-22. Lamburt further discloses:

- displaying at the Web site a list of multiple individually selectable available optional listing enhancements: (see at least abstract, figs.16-22,36, column 10 lines 45-53, column 54 lines 33-53);
- soliciting at the website a selection by the customer: of one or more of the optional listing enhancements (see at least figs.16-22, column 10 lines 45-53, column 54 lines 33-53).
- receiving at least one request from the customer via the Web site: to include at least one feature in the listing of the business in the business directory, including receiving a first enhancement request from the customer via the Web site to

include in the listing of the business in the business directory a first optional listing enhancement from the list of available optional listing enhancements, and including receiving a second enhancement request from the customer via the web site to include in the listing of the business in the business directory a second optional listing enhancement from the list of available optional listing enhancements, whereby the customer configures a particular, unique, individualized, customized business listing, request from the customer to place the order for the listing of a business in a business directory including the at least one optional listing enhancement requested by the customer (see at least abstract, figs.16-22,36, column 10 lines 45-53, column 54 lines 33-53);

- generating a customized price quote: for the particular, unique, individualized, customized business listing configured by the customer, ordered by the customer, wherein the step of generating the customized price quote includes calculating the customized price quote based on the particular features requested by the customer to be included in the particular, unique, individualized, customized business listing (see at least figs.16-17,19-20,33); displaying the customized price quote for the particular, unique, individualized, customized business listing at the website to the customer (see at least figs.16-22, column 10 lines 45-53, column 54 lines 33-53);
- the business directory is a classified business directory: (see at least figs.3,9-22,43-44);

- displaying to the customer at the Web site a solicitation to enhance the listing:
with at least one optional listing enhancement, wherein the at least one optional listing enhancement can be purchased with an associated fee (see at least figs.16-22); receiving listing information from the customer at the Web site, wherein the listing information includes basic business information (see at least figs.16-22).
- receiving listing information from the customer at the Web site: the listing information including at least one of business market information, business category information and optional listing enhancement information relating to the placement and/or appearance of the listing in the business directory: basic business information including a business name, a business address, and a business telephone number, business market information including a region or market in which the customer wishes the business listing to appear, business category information including at least one business category under which the customer wishes to list the business in the business directory, also providing for at least two categories under which the customer wishes to list the business in the business directory (see at least figs.9,11-17,19-21,41,44,54-58,68-70); displaying at the Web site a list of available business categories and subcategories and receiving from the customer at the Web site a selection of a business category and subcategory from the list of available business categories and subcategories (see at least figs.9,11-17,19-21,41,44,54-58,68-70).

- receiving listing information from the customer at the Web site: the listing information including at least one of business market information, business category information and optional listing enhancement information relating to the placement and/or appearance of the listing in the business directory: including optional listing enhancement information that includes graphical and/or textual indicia the customer wishes to appear on the listing in the business directory, the graphical and/or textual indicia including at least one of a customer Web site link, a customer email link, enhanced text, listing highlighting, and a link to a supplemental listing, including a link to an enhanced listing, further including receiving supplemental information from the customer at the Web site that the customer wishes to be displayed when the link to the supplemental listing is accessed by a directory user, and also including receiving enhanced text information from the customer at the Web site that the customer wishes to appear on the listing in the business directory (see at least figs.3,9,15-22,42,44,46,54-55; column 1 lines 8-34, column 10 lines 45-56).
- displaying at the web site a solicitation for billing information from the customer: receiving billing information from the customer at the Web site (see at least fig.22. Please note: The customer's identifying information, whether it is called contact information or billing information, is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in

terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).

- displaying a statement of terms and conditions to the customer at the Web site: and receiving confirmation of acceptance of the terms and conditions from the customer at the Web site (see at least figs.19-20, column 18 lines 14-29).
- generating an order confirmation and displaying it to the customer: at the Web site (see at least abstract, figs.19-20,22,36; column 10 lines 18-45. Please note: it is an inherent aspect of the "Purchase Ads Online" option and the option to see how the listing appears that the order confirmation would then be displayed to the customer, at least in the form of showing the customer's listing).
- the order serving to provide enhancements to an existing business listing: in the business directory (see at least figs.16-17,19,54-55; column 10 lines 45-51, column 55 line 48-column 56 line 37).
- business directory is an online business directory: (see at least figs.9-22).
- sending the customer an email: including information regarding the order for the listing in the business directory (see at least fig.22; column 16 lines 32-50).

Lamburt teaches all the above as noted. Lamburt teaches a) providing a business directory, b) soliciting orders for listings in a business directory, c) providing a website accessible by customers, d) displaying listing options and enhancements available to customers for enhancing their business listings, and e) displaying price quotes for customized business listings. Lamburt however does not disclose the second optional listing enhancement selectable by the customer independently of the

first optional listing enhancement. Superpages teaches a) providing a business directory, b) soliciting orders for listings in a business directory, c) providing a website accessible by customers, d) displaying listing options and enhancements available to customers for enhancing their business listings, and e) displaying price quotes for customized business listings. Superpages further teaches the second optional listing enhancement selectable by the customer independently of the first optional listing enhancement (see at least items U2,V5,W3,W5, and X3). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Lamburt to explicitly disclose the second optional listing enhancement selectable by the customer independently of the first optional listing enhancement, as disclosed by Superpages, in order to fully realize the greater utility inherent in the disclosure, and thereby allow the invention to achieve greater use in commerce.

3. Claims 16,24-28,44,52-56,72, and 80-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamburt (Paper #20061105; US Patent No.6,374,241) in view of Superpages (a collection of prior art cited in Paper # 050715, PTO-892, Items U1-X7; See MPEP §2131.01) as applied to claims 1-2,4,6-15,19-23,29-30,32,34-43,47-51,57-58,60,62-71, 75-79 and 85 above, and further in view of Wagner (US Patent No. 7,062,466 B2).

Lamburt in view of Superpages discloses all of the above as noted but does not explicitly disclose using the billing information received from the customer via the web site to issue a bill to the customer. Wagner also teaches a) providing a business

directory, b) soliciting orders for listings in a business directory, c) providing a website accessible by customers, d) displaying listing options and enhancements available to customers for enhancing their business listings, and e) displaying price quotes for customized business listings. Wagner further explicitly discloses using the billing information received from the customer via the web site to issue a bill to the customer (see at least abstract, figs.1,3-6,8). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Lamburt in view of Superpages to include using the billing information received from the customer via the web site to issue a bill to the customer as taught in Wagner, in order to realize a benefit to the user of using the invention in commerce.

Pertaining to system Claims 29-30,32,34-44, and 47-56

Rejection of Claims 29-30,32,34-44, and 47-56 is based on the same rationale as noted above (Please note: the means for accomplishing each step of the method as disclosed in the reference is either disclosed or inherent in each specific section of the reference that discloses the step in the method).

Pertaining to computer program product Claims 57-58,60,62-72, and 75-84

Rejection of Claims 57-58,60,62-72, and 75-84 is based on the same rationale as noted above. In addition, Lamburt discloses a computer program product (see at least abstract, column 22 line 66-column 23 line 11, column 68 lines 16-39).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM LEVINE whose telephone number is (571)272-8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art
Unit 3625

Adam Levine
Patent Examiner
July 1, 2008